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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,063	10/16/2006	Whye-Kei Lye	P31343US	6849
28390 7590 02/04/2010 MEDTRONIC VASCULAR, INC. IP LEGAL DEPARTMENT 3576 UNOCAL PLACE SANTA ROSA, CA 95403				
EXAMINER PREBILIC, PAUL B				
ART UNIT 3774		PAPER NUMBER		
NOTIFICATION DATE 02/04/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.vasciplegal@medtronic.com

### Office Action Summary

**Application No.**

10/521,063

**Applicant(s)**

LYE ET AL.

**Examiner**

Paul B. Prebille

**Art Unit**

3774

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 8-13, 21 and 26-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14-20 and 22-25 is/are rejected.
- 7) ☒ Claim(s) 1 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/11/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/19/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### ***Election/Restrictions***

Claims 8-13, 21, and 26-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 13, 2009. The Applicant elected Group I, Species B (Figure 3), Figure 6A, and Figure 8 from the different species sets.

Upon review of the claims, it is not seen how the election of Species B (Figure 3) can support a microstructure embedded in a wall or inside a wall as set forth in present claims 3 and 4. It appears that claims 3 and 4 are directed to the embodiment or species of Figures 1, 7, and 12. The Applicant is respectfully requested to review claims 3 and 4 and reevaluate whether they are drawn to the elected species.

### ***Specification***

The disclosure is objected to because of the following informalities: on page 1 of the specification, paragraph [0002] appears incomplete.

Appropriate correction is required.

### ***Claim Objections***

Claims 1 and 7 are objected to because of the following informalities:

In claim 1, on line 8, "the body" lacks clear antecedent basis; the Examiner suggests utilizing the language ---the at least one expandable body--- in place of the present claim language.

In claim 7, on lines 1-2, the language "at least one microstructure comprises a plurality" appears incomplete; the Examiner suggests inserting the language ---of microstructures--- thereafter in order to overcome this objection.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 14, 15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bachinski et al (US 6,036,702). Bachinski anticipates the claim language where the tube as claimed is the graft conduit (430, 530) of Bachinski (it is a tube so it can inherently be fitted within an aneurysm; see Figures 34 and 35 of Bachinski), the expandable body as claimed is the connector structure (449) of Bachinski, and the microstructure as claimed is the strut(s) (436') of Bachinski; see Figure 29a, column 12, lines 4-16, and Figures 34a and 36 of Bachinski.

Regarding claims 2 and 4, the Applicant is directed to column 17, lines 10-12 of Bachinski.

Regarding claim 3, since part of the connector is embedded through the wall, this claim language is considered fully met (see Figure 35).

Regarding claim 14, the Applicant is directed to see column 17, line 62 to column 18, line 12.

Regarding claim 17, the lumen as claimed is the lumen of the graft conduit (530) when the connector (449) is on the outside of the graft conduit (530).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bachinski et al (US 6,036,702) alone. Bachinski meets the claim language as explained in the Section 102 rejection but fails to disclose a coating on the microstructure connector as required. However, since Bachinski teaches that it was known to coat both the inside and outside of the graft conduit with a material, it is the Examiner's position that it would have been considered clearly obvious to an ordinary artisan to coat the connector at is intimately connected thereto as well.

Claims 18-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bachinski et al (US 6,036,702) in view of Randall et al (US 7,331,992). Bachinski fails to disclose a microstructure connector with first and second supports as claimed. However, Randall teaches that it was known to the art to connect similar connectors across bends of a serpentine ring; see the abstract and figures. Therefore, it is the Examiner's position that it would have been considered *prima facie* obvious to an ordinary artisan to utilize a connect with barbs that straddle serpentine

bends for the same reasons that Randall utilizes the same or because this constitutes a substitution of one known barb system for another to yield a predictable result.

### ***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3774